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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,605	07/10/2003	Sheng-li Pan	10420031-1	1582
40079	7590	02/25/2004	EXAMINER	
YUAN QING JIANG P.O. BOX 61214 PALO ALTO, CA 94306			DENTZ, BERNARD I	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,605	PAN ET AL.	
	Examiner	Art Unit	
	Bernard Dentz	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02-24-2004</u> . | 6) <input type="checkbox"/> Other: ____. |

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1 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In 1 Y is not defined. In 3 the formula in parenthesis depicts an isobutyl and not the recited t-butyl group. In 4 "therapeutically" should be inserted before "effective". "Chemically modified compound" is vague and indefinite in 10. Therapeutically effective should be inserted before "salt" in 11. "Prodrug" in claim 12 is vague and indefinite.

Claims 1-3 and 18 are rejected as unpatentable under 35 USC 101 as not representing a new invention. Claims 1-3 recite compounds which include a compound which has been extracted from Piper Laetispicum a plant which applicants state in the paragraph bridging p. 6 and 7 of the specification has been used in China for a long time to treat rheumatism. Applicants also claim a pharmaceutical composition and a method of alleviating inflammation and pain using the compound. Applicants thus need to recite "an essentially pure compound having the following structure" before the independent claims. This is because the compound is not new in nature while the essentially pure compound is.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Banerji et al, Phytochemistry, vol., p. 897-901 (April 17 2002). It discloses the isolation and structural characterization of a compound from *Piper brachystachyum* Wall denoted as (4). It falls within the genus of claims 1 and 2. It has the following structure:



See p. 897, second column to the paragraph ending at the middle of p. 899 and the first 4 paragraphs under Experimental at p. 899 and 900. It reads on claim 1 when R₂ is hydrogen, n is 3, the 7-8 bond is single, Z is =O, Y is NH and R₁ is isobutyl.

Any inquiry concerning this communication should be directed to Bernard Dentz at telephone number 703 308-4544.

B. Dentz

Feb. 24, 2004

BERNARD DENTZ
PRIMARY EXAMINER
GROUP 1600